

REMARKS

Claims 93-121 are presented for examination.

Independent Claims 93 and 109 have been amended and new Claims 116-121 have been added.

Applicants acknowledge with appreciation the allowance of Claims 113-115 and the indication of the allowability of Claims 102-106 and 108 suitably amended. Newly added Claims 116-121 are the allowable claims rewritten, as required by the Examiner, in independent form including all the limitations of the base claim and any intervening claims.

Applicants' Claims 93, 96-100 and 109-111 stand rejected under 35 U.S.C. 102(b) as being anticipated by *Black*. This rejection is respectfully traversed.

As originally submitted and as now amended, Claim 93 calls for a spacer intermediate the first and second member for transmitting torque and weight. To emphasize this feature regarding weight transmission, the claim has been amended to call for the spacer to be axially and laterally intermediate the first and second members. Applicants' Claim 109, as originally submitted, and as currently amended, calls for a transfer member for transmitting weight and torque between the first member and the second member. As currently amended, Claim 109 recites that the transfer member extends axially and laterally between the first member and the second member to emphasize the fact that weight is being transmitted through the transfer member.

Black has neither a "spacer" such as recited in Claim 93 nor a "transfer member" as recited in Claim 109 between the corresponding structure representing *Black's* first and second members. Note applicants' specification and drawings wherein the various modifications are illustrated with spacers or transfer members disposed axially and laterally between the first and second members of the apparatus used in the drill string and drill bit assembly. See *Black* at column 2, line 10 *et seq* noting that "The transverse face 24 of the socket 22 bears against the shoulder 24a at the base of the extension 21 and the transverse face 25 of the extension 21 bears against the flat bottom 25a of the socket 22." It is respectfully noted that there is no spacer or transfer member between the face 24 and shoulder 24a and the face 25 and the flat bottom 25a of the *Black* structure. The axial end areas of the *Black* device bear directly against each other in a contacting metal-to-metal relationship.

It is respectfully submitted that applicants' claims dependent from parent Claims 93 and 109 and rejected over the *Black* reference add additional limitations that are not disclosed in *Black*. Accordingly, for the reasons hereinbefore advanced, it is respectfully submitted that applicants' claims are not anticipated by the *Black* patent and allowance of the claims rejected thereover is respectfully solicited.

Applicants' Claims 93, 94, 100, 107 and 112 stand rejected under 35 U.S.C. 102 (b) as being anticipated by *Bodine*. This rejection is respectfully traversed.

As currently amended and as originally presented, applicants' Claims 93 and 106 call for a spacer or a transfer member for transmitting weight and torque between first and second members. The resiliently deformable member 22 illustrated in *Bodine* does not transmit either torque or weight. The resilient connecting member 22 between the first and second members of *Bodine* is merely a resilient bushing employed as a mud seal and to hold parts together resiliently for relative motion between the oscillator and the jacket portion 25. See *Bodine*, Figure 1 and column 2, lines 22 *et seq.*

Applicants' claims dependent from Claims 93 and 106 add limitations that are neither taught nor suggested in the *Bodine* patent. Accordingly, it is respectfully submitted that for the reasons herein advanced, applicants' claims rejected over the *Bodine* Patent are in fact allowable over such reference and allowance of such claims is respectfully requested.

Applicants' Claims 93 and 95 stand rejected under 35 U.S.C. 102 (b) as being anticipated by *Ortloff*. This rejection is respectfully traversed.

Applicants' Claim 93, as originally presented and as currently amended, calls for a resiliently deformable spacer intermediate the first and second members for transmitting torque and weight. The claim has been amended to add the feature that the spacer is axially and laterally intermediate the first and second members. The *Ortloff* reference does not teach use of a resiliently deformable spacer for transmitting weight. Moreover, the *Ortloff* reference does not teach placing the resiliently deformable spacer axially intermediate the first and second members.

Applicants' Claim 93 further calls for the spacer to be disposed between the first and second members so as to be compressed to allow "tilting of or lateral movement of" the first member relative to the second member under an applied load. It is respectfully noted that resilient material applied between lateral surfaces of the *Ortloff* device are contained within

minimal clearances between the first and second members. See column 2, lines 46 *et seq.* It is respectfully submitted that this mounting with minimal clearances prevents any "tilting of or lateral movement of" the body of the bit relative to the adapter of the *Orloff* assembly.

With respect to the rejection of applicants' claims under 35 U.S.C. §102(b), it is respectfully submitted that rejection of the claims based on a single reference is not justified. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants have pointed out the distinction between the limitations in applicants' claims and the teachings of the single references that have been applied under 35 U.S.C. 102(b). Clearly, no single reference teaches nor even remotely suggests the claims rejected over either of such references.

Allowance of applicants' claims over the single reference rejections is respectfully solicited.

Respectfully submitted,


Carlos A. Torres

Date: **December 10, 2003**
BROWNING BUSHMAN, P.C.
5718 Westheimer, Suite 1800
Houston, Texas 77057
Telephone: (713) 266-5593
Facsimile: (713) 266-5169

EPM TC 3600
FINAL SEARCH DATE 1/8/04
DELIVER TO GOVT DATE 1/8/04

CERTIFICATE OF FIRST-CLASS MAILING

I hereby certify that this correspondence and all referenced enclosures are being deposited by me with the United States Postal Service, postage prepaid as First-Class Mail in an envelope addressed to: Commissioner of Patents, Mail Stop: Amendments, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this the **10th day of December, 2003**.

By: Martha Jeffers

Martha Jeffers